



Application No. 09/866,652
Filed May 30th 2001

Art Unit: 3624

Examiner: Kyle, Charles R.
Applicant: Tommaso Innocenti

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 A. Acknowledgment of Action

2 *Examiner's Note*

3 1. Applicant respectfully acknowledges Examiner's notation: "This action is made non-
4 final based on newly cited references" (Fifth Office Action (5th OA), p. 2, top).

6 *Claim Rejections - 35 USC § 112*

7 2. Applicant respectfully acknowledges Examiner's quotation of the second paragraph
8 of 35 U.S.C. 112.

10 3. Applicant respectfully acknowledges Examiner's rejection of claims 40 - 75 "under
11 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and
12 distinctly claim the subject matter which applicant regards as the invention." (5th OA, page
13 2, 3rd par.) because:

14 Claim 40 and its dependent Claims recite the phrases 'providing the
15 option of provision of a model...' and 'providing the option of provision of a
16 sample...' These phrases do not make clear if a model or sample are ever
17 provided and are read as not being limitations. Additionally, the optional
18 provision does not relate to the rest of the claims language. No use of the
19 quality indications is made in the execution of the auction. An inventive
20 feature such as bid calculation based on indicated quality would perhaps relate
21 these limitations to the rest of the Claim.

24 Claims 53, 54, 57, 60 and 63 recite the qualifier 'may choose', which
25 is unclear as to whether a choice is made. (5th OA, page 2, through)

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 *Claim Rejections - 35 USC § 103*

2 4. Applicant respectfully acknowledges Examiner's quotation of 35 U.S.C. 103(a) as
3 "the basis for all obviousness rejections set forth in this Office action". (5th OA, page 3, top)

4

5 5. Applicant respectfully acknowledges Examiner's rejection of claims 40-41, 43, 46-49,
6 52-54, 59-60 and 62-63 "under 35 U.S.C. 103(a) as being unpatentable over *Lerner* in view
7 of *Moshal et al.*" (5th OA, page 3, 2nd par.)

8

9 6. Applicant respectfully acknowledges Examiner's exposition of the disclosure of
10 *Lerner* with respect to the presently claimed subject matter on pages 3 - 5 of the 5th Office
11 action.

12

13 7. Applicant respectfully acknowledges Examiner's admission that "*Lerner does not*
14 *specifically disclose auction format specification.*" (5th OA, page 5, 3rd par., first sentence,
15 emphasis added)

16

17 8. Applicant respectfully acknowledges Examiner's combination of the *Lerner* and
18 *Mosal et al.* references: "*Moshal discloses auction format specifications for use by traders*
19 *(bidders and sellers) in a trading exchange at Fig. 12; paras. 232-234, and paras. 92-99, at*
20 *least.*" (5th OA, page 5, 3rd par., second sentence)

21

22 9. Applicant respectfully acknowledges Examiner's attribution of motivation for this
23 combination:

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 It would have been obvious to one of ordinary skill in the art at the time the
2 invention was made to have modified the exchange of *Lerner* with the auction
3 format specification disclosed by *Moshal* because this would have obtained
4 the benefits to an exchange specifically set out by *Moshal* at paras. 38-39 and
5 quoted below (particulars (sic) benefits are bolded)" (5th OA, page 5, 3rd par.,
6 last sentence, emphasis added)
7

8
9
10 10. Applicant respectfully acknowledges Examiner's citation from *Moshal et al.* including
11 the following 'bolded' particulars:

12
13 Furthermore, the system is data driven and highly configurable, enabling
14 flexibility with high-capacity.
15

16 A system provided under an embodiment of the invention implements efficient
17 trading software that generates exchanges and auctions based on the common
18 parameters. By varying these parameters, multiple existing and new types of
19 auction, exchanges and other price interactions may be created and conducted
20 for multiple traders using a network such as the Internet.
21

22
23 11. Applicant respectfully acknowledges Examiner's citations in *Moshal* and *Lerner*
24 regarding claims: 41; 43; 46; 47; 48 & 49; 52; 53, 54, 57, 60 & 63; 56 & 62 from the bottom
25 of page 5 through paragraph 7 on page 6 of the 5th Office action.
26

27 12. Applicant respectfully acknowledges Examiner's 're rejection' of 'claims 42' under
28 35 U.S.C. 103(a) as "unpatentable over *Lerner* in view of *Moshal et al.* (sic) and further in view
29 of *Microsoft Press Computer Dictionary*" (5th OA, page 6, penultimate par.)

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 13. Applicant respectfully acknowledges Examiner's admission that *Lerner* and *Moshal et al.* "do not specifically disclose that the buyer and seller websites are different." (5th OC, page 6, ultimate par., 3rd sentence, emphasis added)

4

5 14. Applicant respectfully acknowledges Examiner's combination of *Dictionary* with *Lerner* and *Moshal et al.* in support of rejection of claim 42: "*Dictionary* discloses that individual websites on a common server are possible." (5th OC, page 6, ultimate par., 4th sentence)

9

10 15. Applicant respectfully acknowledges Examiner's attribution of motivation for combining *Dictionary* with *Lerner* and *Moshal et al.* in support of rejection of claim 42: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided different websites for buyers and sellers to specify auction types because this would have improved accessibility of the auction specification functionality." (5th OA, pages 6 - 7, emphasis added)

16

17 16. Applicant respectfully acknowledges Examiner's rejection of claims 44- 45, 50-51, 55, 58, 61 and 64 under 35 U.S.C. 103(a) as "unpatentable over *Lerner* in view of *Moshal et al* and further in view of *Auction This*, already of record." (5th OA, page 7, 2nd par.)

20

21 17. Applicant respectfully acknowledges Examiner's citations from *Auction This* in support of the rejection of the claims identified directly above through page 7.

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 18. Applicant respectfully acknowledges Examiner's rejection of claim 71 under 35
2 U.S.C. 103(a) as "unpatentable over *Lerner* in view of *Moshal et al* and further in view of
3 *Conklin et al.* (5th OA. Page 8, top par.)

4

5 19. Applicant respectfully acknowledges Examiner's admission that *Lerner* and *Moshal*
6 *et al.* "*do not disclose direct provision of a sample by a seller to a prospective buyer.*" (5th
7 OA, page 8, 2nd par., 3rd sentence, emphasis added)

8

9 20. Applicant respectfully acknowledges Examiner's citation of Col 8, lines 17-24 as
10 supportive of disclosure of 'direct provision of a sample by a seller to a prospective buyer'
11 by *Conklin*.

12

13 21. Applicant respectfully acknowledges Examiner's attribution of motivation for
14 combining the disclosure of *Conklin* with *Lerner* and *Moshal et al.*:

15

16 It would have been obvious to one of ordinary skill in the art at the time the
17 invention was made to have used seller provided samples as disclosed by
18 *Conklin* in combination with *Lerner* and *Moshal because this would have*
19 *allowed buyers to evaluate potential sellers as set forth by Conklin at the*
20 *same site.* (5th OA, page 8, 2nd par., last sentence, emphasis added)

21

22

23 22. Applicant respectfully acknowledges Examiner's rejection of claims 44- 45, 50-51,
24 55, 58, 61 and 64 under 35 U.S.C. 103(a) as "unpatentable over *Lerner* in view of *Moshal*
25 *et al* and further in view of *Thomas et al.* " (5th OA, page 8, 3rd par.)

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

- 1 23. Applicant respectfully acknowledges Examiner's statements in support of rejection
2 of claims 65 - 70 as 'unpatentable over *Lerner* in view of *Moshal et al* and further in view
3 of *Thomas et al.*': "**As to Claims 65-70**, they are the buyer side of sample provision. See the
4 discussion of Claims 71 and 72-76 below." (5th OA., page 8, 4th par., top)
- 5
- 6 24. Applicant respectfully acknowledges Examiner's attribution of motivation for claims
7 65-70 being 'the buyer side of sample provision': "It would have been obvious to one of
8 ordinary skill in the art at the time the invention was made to have for (sic) a buyer to
9 provide a sample/model specifying the quality of commodities *because this would have*
10 *allowed the seller to know exactly the qualities desired.*" (5th OA., page 8, 4th par., last,
11 emphasis added)
- 12
- 13 25. Applicant respectfully acknowledges Examiner's citation of "para. 62 whereby the
14 system", suggested by *Lerner* as receiving "a sample from a seller", "provides access to
15 laboratory testing. (5th OA, page 8, par. 5)
- 16
- 17 26. Applicant respectfully acknowledges Examiner's admission that *Lerner* and *Moshal et al.* do not "*disclose that laboratory test results are posted to a website.*" (5th OA, page 8, par. 6, emphasis added)
- 20
- 21 27. Applicant respectfully acknowledges Examiner's citation of paragraph 45 of *Thomas* disclosing posting of laboratory test results to a website. (5th OA, page 8, par. 6)
- 23

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 28. Applicant respectfully acknowledges Examiner's attribution of the motivation for
2 "one of ordinary skill ... to have posted laboratory results on a website": "*because this would*
3 *have allowed the buyer to identify a lot which most closely conformed to requirements, as*
4 *set forth at the same cite.*" (5th OA, pages 8-9, emphasis added)

5
6 29. Applicant respectfully acknowledges Examiner's attribution of motivation, with
7 respect to claim 74, "for the auction house to have been a conduit for the seller to buyer
8 sample transfer *because this would have allowed the contracting parties to maintain*
9 *anonymity.*" (5th OA, page 9, 2nd par., emphasis added)

10
11 30. Applicant respectfully acknowledges Examiner's comments with respect to claim 75:
12
13 to provide proportional divisions of a sample to prospective buyers for
14 assessment because this would have assured comparable sub-samples and
15 would have allowed bidders to adjust their bids based on equivalent quality of
16 sub-samples. This is 'comparing apples to apples' - literally. (5th OA, page 9,
17 3rd par.)

18
19
20 31. Applicant respectfully acknowledges Examiner's specific regard to claim 76:
21 **"Concerning Claim 76, see the discussion of claim 75."** (5th OA, page 9, 3rd par.)

Response to Arguments

22
23 32. Applicant respectfully recites in full Examiner's response to the Arguments presented
24 by Applicant in the fourth Office action requesting continued examination with preliminary

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 amendment: "Applicant's arguments with respect to the claims have been considered but are
2 moot in view of the new ground(s) of rejection." (5th OA, page 9)

Conclusion

5 33. Applicant respectfully acknowledges Examiner's direction of inquiry to his office and
6 provision of telephone number for the same, his supervisor, official and after final facsimile
7 communication and group reception. (5th OA, pages 9-10)

B. Errors in Examination

Claim Rejections - 35 USC § 112

12 1. Applicant respectfully submits that Examiner's rejection of claims 40 - 75, and
13 rejection of claims 53, 54, 57, 59, 60 and 63, under 35 U.S.C. 112, second paragraph, is in
14 error because, by Examiner's own repeated usage, the provision of an option, regardless of
15 whether or not the option is exercised, comprises a valid claim limitation:

- 16 a. "this would have *allowed* buyers to evaluate potential sellers as set forth by *Conklin*"
17 (FOA, page 8, 2nd par., emphasis added);
- 18 b. "this would have *allowed* the seller to know exactly the qualities desired" (FOA, page
19 8, 4th par., emphasis added);
- 20 c. "this would have *allowed* the buyer to identify a lot which most closely conformed
21 to requirements" (page 9, top, emphasis added);
- 22 d. "this would have *allowed* the contracting parties to maintain anonymity" (FOA, page
23 9, 2nd par., emphasis added);

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 “This would have ... *allowed* bidders to adjust their bids based on equivalent quality
2 of subsamples”. (FOA, page 9, 3rd par., emphasis added);
3 as ‘allowing’ an action is merely the provision of an option that can be exercised or not
4 according to the participant’s choice and this cannot be dictated by the language of a patent
5 claim: providing the option is all that is possible and provision of that option is certainly a
6 valid claim limitation.

7
8 *Claim Rejections - 35 USC § 103*
9 2. Applicant respectfully submits that the rejection of present base claim 40, and claims:
10 41, 43, 46 - 49, 52 - 54, 59-60, 62 and 63 under 35 U.S.C. 35 103(a), is in error by
11 Examiner’s own admission that: “*Lerner does not specifically disclose auction format*
12 *specification.*” (5th OA, page 5, 3rd par. , first sentence, emphasis added); without which it
13 is not possible for:

14 a. “completion of a submission for initiating an open bid” (FOA, page 3, 4th par.; or
15 b. “completion of a submission for initiating an open offer”(FOA, pages 3 - 4);
16 the first and third steps, respectively, of the presently claimed invention attributed to
17 disclosure by *Lerner*.

18
19 3. Applicant respectfully submits that the rejection of present base claim 40 under 35
20 U.S.C. 103(a), and claims: 41, 43, 46 - 49, 52 - 54, 59-60, 62 and 63, is in error because the
21 motivation attributed to the prior art for the suggestion of combining the two references
22 relied upon in rejection is lacking: “*because this would have obtained the benefits to an*
23 *exchange specifically set out by Moshal* at paras. 38-39 and quoted below (particulars (sic)

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 benefits are bolded)" (5th OA, page 5, 3rd par., last sentence, emphasis added); fails to specify
2 any particular benefits, only "multiple existing and new types of auction" that "may be
3 created and conducted":

4
5 Furthermore, the system is data driven and highly configurable, enabling
6 flexibility with high-capacity.

7
8 A system provided under an embodiment of the invention implements efficient
9 trading software that generates exchanges and auctions based on the common
10 parameters. By varying these parameters, multiple existing and new types of
11 auction, exchanges and other price interactions may be created and conducted
12 for multiple traders using a network such as the Internet. (FOA, page 5, 4th &
13 5th paragraphs).

14
15
16 4. Applicant respectfully submits that the rejection of claim 42 under 35 U.S.C. 103(a)
17 conveyed in the fifth Office action is in error because, by Examiner's admission, *Lerner* and
18 *Moshal et al.* "*do not specifically disclose that the buyer and seller websites are different.*"
19 (5th OC, page 6, ultimate par., 3rd sentence, emphasis added) and the motivation for
20 combining *Dictionary* with *Lerner* and *Moshal et al.* in support of rejection of claim 42: "It
21 would have been obvious to one of ordinary skill in the art at the time the invention was
22 made to have provided different websites for buyers and sellers to specify auction types
23 *because this would have improved accessibility of the auction specification functionality.*"
24 (5th OA, pages 6 - 7, emphasis added); is bereft of attribution to the prior art and also makes
25 no sense: use of different web sites does not improve Internet accessibility; but regardless
26 of the benefit the improvement is neither attributed to, nor suggested by, the prior art.

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 5. Applicant respectfully submits that Examiner's entire 'Response to Arguments'
2 presented by Applicant: 'have been considered but are moot in view of the new ground(s)
3 of rejection'; is in error as demonstrated by Examiner's rejection of claims 44- 45, 50-51,
4 55, 58, 61 and 64 under 35 U.S.C. 103(a) as "unpatentable over *Lerner* in view of *Moshal*
5 *et al* and further in view of *Auction This*, already of record." (5th OA, page 7, 2nd par.)

6
7 6. Applicant respectfully submits that Examiner's rejection of claim 71 under 35 U.S.C.
8 103(a) is in error because Examiner admits that *Lerner* and *Moshal et al.* "*do not disclose*
9 *direct provision of a sample by a seller to a prospective buyer.*" (5th OA, page 8, 2nd par., 3rd
10 sentence, emphasis added) and the reason for combining *Conklin* with *Lerner* and *Moshal*:
11 "*because this would have allowed buyers to evaluate potential sellers as set forth by*
12 *Conklin at the same site.* (5th OA, page 8, 2nd par., last sentence, emphasis added); is bereft
13 of both the motivation, and the attribution of the motivation, to the prior art and the specific
14 passage cited in support is merely a reference to common commerce practice, performed by
15 foot, mentioned in the rather lengthy, 13 columns, 'Background of the Invention' of *Conklin*:

16
17 In many corporations, the election of a new supplier for production
18 purchases usually involves the creation of a team from purchasing,
19 engineering, and manufacturing to evaluate all potential sellers. *The team*
20 *usually flies to potential vendor sites to evaluate capabilities and production*
21 *facilities, obtain samples, and then return home to evaluate the samples.*
22 (*Conkling*, column 8, lines 17 - 24, emphasis added);

23
24 and suggests only that a team of personnel 'usually flies to vendor sites' or physical
25 locations, not Internet web 'sites', 'to evaluate capabilities and production facilities', not
26 prospective sellers of an online commodities auction, and 'obtain samples', from the vendor,

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 before 'returning home to evaluate the samples'.

2

3 7. Applicant respectfully submits that the rejection of claims 65 - 70 under 35 U.S.C.
4 103(a) is in error because the attribution given for the motivation to combine references: "to
5 have for (sic) a buyer to provide a sample/model specifying the quality of commodities
6 *because this would have allowed the seller to know exactly the qualities desired.*" (5th OA.,
7 page 8, 4th par., last, emphasis added); is neither attributed to, nor found in, the prior art.

8

9 8. Applicant respectfully submits that the rejection of claim 72 under 35 U.S.C. 103(a)
10 is in error because Examiner admits that *Lerner and Moshal et al.* do not "*disclose that*
11 *laboratory test results are posted to a website.*" (5th OA, page 8, par. 6, emphasis added)
12 and the motivation for this contribution; "to have posted laboratory results on a website":
13 "*because this would have allowed the buyer to identify a lot which most closely conformed*
14 *to requirements, as set forth at the same cite*" (5th OA, pages 8-9, emphasis added); is
15 neither attributed to, nor found in, the prior art.

16

17 9. Applicant respectfully submits that the rejection of claim 74 under 35 U.S.C. 103(a)
18 is in error because the motivation for this contribution: "*because this would have allowed*
19 *the contracting parties to maintain anonymity.*" (5th OA, page 9, 2nd par., emphasis added)
20 is neither attributed to, nor found in, the prior art.

21

22 10. Applicant respectfully submits that the rejection of claims 65 - 70 is in error because
23 the equation of a sample and a model: "It would have been obvious ... to have for (sic) a

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 buyer to provide a sample /model" (FOA, page 8, 2nd par.) ignores the difference between
2 buyers and sellers, the most fundamental distinction known regarding auctions generally, and
3 the suggestion for the combination or modification in the prior art or knowledge generally
4 available to one of ordinary skill at the time of the invention, in this instance the equation of
5 a prospective buyer supplied model with a prospective seller provided sample, and in the
6 instances related above in paragraphs B. 3, 4, 6 - 9, is neither attributed to nor found in the
7 prior art as clearly stipulated by MPEP 2143 and 2143.01 cited herein as authority for the
8 necessity of the prior art providing the suggestion for modification or combination of prior
9 art elements and also of providing the 'reasonable expectation of success' lacking in every
10 instance related herein:

2143 Basic Requirements of a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

2143.01 Suggestion or Motivation To Modify the References [R-1] **THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION**

'There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.' *In re Rouffet*,

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)
2

3 ‘In determining the propriety of the Patent Office case for obviousness
4 in the first instance, it is necessary to ascertain whether or not the reference
5 teachings would appear to be sufficient for one of ordinary skill in the relevant
6 art having the reference before him to make the proposed substitution,
7 combination or other modification.’ *In re Linter*, 458 F.2d 1013, 1016, 173
8 USPQ 560, 562 (CCPA 1972)

9 Obviousness can only be established by combining or modifying the
10 teachings of the prior art to produce the claimed invention where there is some
11 teaching, suggestion, or motivation to do so *found either explicitly or*
12 implicitly *in the references themselves* (emphasis added) or in the knowledge
13 generally available to one of ordinary skill in the art. ‘The test for an implicit
14 showing is what the combined teachings, knowledge of one of ordinary skill
15 in the art, and the nature of the problem to be solved as a while would have
16 suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365,
17 1370, 55 USPQ2d 1313, 1317 (Fed Cir. 2000) See also > *In re Lee*, 277 F.3d
18 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the
19 importance of relying on objective evidence and making specific factual
20 findings with respect to the motivation to combine references; < *In re Fine*, ...
21

22 *In In re Fine... The examiner and Board asserted that it would have*
23 *been within the skill of the art to substitute one type of detector for another*
24 *in the system of the primary reference, however, the court found there was no*
25 *support or explanation of this conclusion and reversed.* (MPEP 2100-124-5)
26 (emphasis added);
27

28 C. Submission of Evidence Overcoming Grounds of Rejection

30 *Claim Rejections - 35 USC § 112*

31 1. Applicant respectfully submits that Examiner’s rejection of claims 40 - 75, and
32 rejection of claims 53, 54, 57, 59, 60 and 63, under 35 U.S.C. 112, second paragraph, is

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 overcome by the fact that:

2 a. "the meaning of the term in question is unambiguously set forth in the
3 specification²¹⁴",

4 as demonstrated below and the determination by the Appeals Court of the Federal circuit
5 that:

6 b. "(a)ccordingly, extrinsic evidence is irrelevant to the issue of indefiniteness²¹⁴"; and

7 c. "resolution of claim definiteness is part of the court's performance of its duty as
8 construer of patent claims²¹³"; and

9 d. neither "interpretation" nor "construction" "go to claim validity for failure to comply
10 with the second paragraph of §112"²¹² (Robert L. Harmon, *Patents and the Federal*
11 *Circuit*, p. 257 citing: ²¹²*Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 12
12 USPQ2d 1474 (Fed. Cir. 1989), ²¹³*Personalized Media Comm. LLC v. United States*
13 *ITC*, 161 F.3d 696, 48 USPQ2d 1880, 1889 (Fed. Cir. 1998)., 887 F.2d 1050, 12
14 USPQ2d 1474 (Fed. Cir. 1998, ²¹⁴*Ibid*; et al.

15

16 2. Applicant respectfully submits that the 'terms in question':

17 'providing the option of provision of a model'; and

18 'providing the option of provision of a sample';

19 in rejection of present claims 40 - 75 under 35 U.S.C. 112, second paragraph, are
20 unambiguously defined in the original specification as filed:

21

22 In general, at least two options are recognized for each of the auction
23 parameters which may be varied. The delivery date can be advanced or
24 retarded, the quantity 31 decreased or increased, and delivery terms 32 may
25 be varied with respect to how and where. Payment terms 33 can include: (a)

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

letter of credit; (b) payment x days after invoice; (c) payment x days after delivery; (d) cash upon delivery; (e) cash against documents, i.e. title; and letter of credit x days after delivery. *And quality specification 35 may be varied with respect to what is desired and how it is ascertained which is facilitated by the optional use of samples 56 and its converse, models 57, which are examples provided by the initiator of an open bid 17. Parties making an open offer 16 or counter offer 26 may provide a sample 56. In the case that the auction of given lot is initiated by an open offer 16 no models 57 are anticipated. If, however, the auction is initiated by an open bid 17 models 57 may be provided and/or samples 56 requested.* (Page 19, penultimate paragraph, emphasis added)

3. Applicant respectfully submits, with regard to the term ‘may choose’ and rejection of claims 53, 54, 57, 59, 60 and 63 under 35 U.S.C. 112, second paragraph, for possession of this term, that ‘may choose’, as clearly seen in each instance of its use:

53. The business method of claim 40 wherein said prospective seller, in specification of the type of auction, *may choose upward, open, unconstrained bidding wherein said listing specifies an initial minimum price and bidding within the time between said commencement and conclusion dates is otherwise unconstrained with regard to price.*

54. The business method of claim 40 wherein said prospective seller, in specification of the type of auction, *may choose upward, incremental, unconstrained bidding wherein said listing specifies an initial minimum price and bidding within the time between said commencement and conclusion dates is otherwise only constrained with regard to price by the progressive increase of the same in predetermined increments.*

57. The business method of claim 40 wherein said prospective seller, in specification of the type of auction, *may choose downward, incremental,*

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 *constrained bidding wherein said listing specifies an initial maximum price*
2 *and bidding within the time between said commencement and conclusion*
3 *dates is constrained with regard to price by the progressive decrease of the*
4 *same in predetermined increments and by a predetermined minimum price*
5 *which is not posted in said listing.*

6
7 *59. The business method of claim 40 wherein said prospective buyer, in*
8 *specification of the type of auction, may choose downward, open,*
9 *unconstrained offering wherein said listing specifies an initial maximum*
10 *price and offering within the time between said commencement and*
11 *conclusion dates is otherwise unconstrained with regard to price.*

12
13 *60. The business method of claim 40 wherein said prospective buyer, in*
14 *specification of the type of auction, may choose downward, incremental,*
15 *unconstrained offering wherein said listing specifies an initial maximum*
16 *price and offering within the time between said commencement and*
17 *conclusion dates is otherwise only constrained with regard to price by the*
18 *progressive decrease of the same in predetermined increments.*

19
20 *63. The business method of claim 40 wherein said prospective buyer, in*
21 *specification of the type of auction, may choose upward, incremental,*
22 *constrained bidding wherein said listing specifies an initial minimum price*
23 *and offering within the time between said commencement and conclusion*
24 *dates is constrained with regard to price by the progressive increase of the*
25 *same in predetermined increments and by a predetermined maximum price*
26 *which is not posted in said listing. (emphasis added)*

27
28 refers, in each instance, only to a specific option ‘in specification of the type of auction’ that
29 is, in each instance, fully defined in detail and therefore the language of each claim is wholly
30 unambiguous and definite.

31
32 continued

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 *Claim Rejections - 35 USC § 103*

2 4. Applicant respectfully submits that the Declaration Under 37 CFR §1.131 attached
3 hereto executed by the Inventor and present Applicant, and the photocopy of original Exhibit
4 A, a facsimile enquiry by the present Inventor seeking patent coverage for the presently
5 claimed invention received by the present Agent of Record on June 15th 2000, comprise a
6 showing of facts establishing conception of the invention, due diligence, and reduction to
7 practice in the form of the original application for patent, i.e. invention, prior to the effective
8 date of the *Lerner* reference: i.e. July 18th 2000; thereby overcoming all grounds of rejection
9 relying upon references with an effective date later than June 15th 2000 including all the
10 rejections relying upon *Lerner* as prior art: i.e. all rejections under 35 U.S.C. 103(a)
11 conveyed in the fifth Office action.

12
13 5. Applicant respectfully submits that regardless of the fact established by the
14 declaration of prior invention under 37 CFR §1.131 that *Lerner* is not prior art a number of
15 limitations to the present base claim, 40, from which all other present claims are properly
16 dependent, are undisclosed by the combination of *Lerner* and *Moshal et al.* relied solely
17 upon in rejection of said base claim including:

- 18 a. providing, upon a web site ... a proposal format *in which the type of auction can be*
19 *specified* in addition to the particular commodity, weight, price, and specific
20 commodity category dependent quality characteristics desired by a prospective buyer
21 *in completion of a submission for initiating an open bid*;
- 22 b. *providing the option of provision of a model* of a particular commodity desired for
23 purposes of indicating the quality desired by a prospective buyer;

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

- 1 c. providing, upon a web site accessible upon the world wide web, a proposal format *in*
2 *which the type of auction can be specified* in addition to the particular commodity,
3 weight, price, and specific commodity dependent quality characteristics offered by
4 a prospective seller *in completion of a submission for initiating an open offer*;
- 5 d. *providing the option of provision of a sample* of a particular commodity desired for
6 purposes of indicating the quality desired by a prospective seller;
- 7 by Examiner's own admission: "Lerner does not specifically disclose auction format
8 specification" (5th OA, page 5, 3rd par., first sentence) hence denying the steps of specifying
9 the type of auction in a proposal format in completion of a submission initiating either an
10 open bid or offer as the motivation for combining the teachings of *Moshal et al.* consists of
11 prior art speculation of "multiple existing and new types of auction" that 'may be created
12 and conducted'" (above, paragraph B.3); and "*Lerner and Moshal et al. 'do not disclose*
13 *provision of a sample by a seller to a prospective buyer*" (above, paragraph B. 6) and
14 therefore cannot disclose the step of providing the option of provision of a sample or model.
- 15
- 16 6. Applicant respectfully submits that the language of the four steps in present base
17 claim 40 identified above, and of other steps thereto, patentably distinguish the presently
18 claimed invention over the prior art by offering an online auction format for commodities
19 that allows prospective sellers and buyers to specify the type of auction "in addition to the
20 particular commodity, weight, price, and specific commodity category dependent quality
21 characteristics desired" in a submission initiating either an open offer or bid, according to
22 the originator, and provides for the option of providing either a sample or model
23 representative of the quality offered or sought, respectively, by a prospective seller or buyer.

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 7. Applicant respectfully submits that the language of the four steps in present base
2 claim 40 identified above, and of other steps thereto, comprise the patentably novelty
3 presented by the claims in view of the prior art: offering an online auction format for
4 commodities that allows prospective sellers and buyers to specify the type of auction “in
5 addition to the particular commodity, weight, price, and specific commodity category
6 dependent quality characteristics desired” in a submission initiating either an open offer or
7 bid, according to the originator, and provides for the option of providing either a sample or
8 model representative of the quality offered or sought, respectively, by a prospective seller
9 or buyer.

10

11

12 D. Summary and Request for Reconsideration/Allowance

13 1. Applicant respectfully submits that the present response has been timely filed with the
14 surcharge for reply in the fourth month from the date of the ultimate, fifth, Office action:
15 October 4th 2003.

16

17 2. Applicant respectfully submits that the present response:

18 a. ‘distinctly and specifically points out the supposed errors in the examiner’s action’;
19 b. ‘replies to every ground of objection and rejection in the prior Office action’;
20 c. presents ‘arguments pointing out the specific distinctions believed to render the
21 claims, including any newly presented claims, patentable over any applied references’
22 (37 CFR § 1.111).

23

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 3. Applicant respectfully submits that all the requirements of 37 CFR §§ 1.111 & 1.112
2 have been meet herein and further respectfully requests, in accordance with 37 CFR § 1.112,
3 reconsideration of the present application for patent.

4

5 4. Applicant respectfully submits that all grounds for rejection under 35 U.S.C. 112 have
6 been overcome by the demonstration above that 'provision of the option of providing' a
7 model, if a prospective seller, and a sample, if a prospective buyer, is comprised of terms
8 fully defined by the specification as filed and that the term 'may choose' has been
9 demonstrated to refer, in each instance, to a single fully defined option.

10

11 5. Applicant respectfully submits that all the grounds of rejection under 35 U.S.C. 35
12 103(a) conveyed in the fifth Office action have been overcome by the demonstration above
13 that by Examiner's admission that 'Lerner does not specifically disclose auction format
14 specification', that *Lerner* and *Moshal et al.* neither 'disclose provision of a sample by a
15 seller to a prospective buyer', nor 'specifically disclose that the buyer and seller websites are
16 different'; and reliance upon speculation: 'multiple existing and new types of auction' that
17 'may be created and conducted'; as the suggestion or motivation in the prior art necessary
18 for combining these references.

19

20 6. Applicant respectfully submits that all the grounds of rejection under 35 U.S.C. 35
21 103(a) have been overcome by the demonstration above that the presently claimed invention
22 is patentably distinguished over the prior art by the language of present base claim 40
23 specifying a 'proposal format in which the type of auction can be specified ... in completion

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 of submission initiating an open bid' and 'initiating and open offer' by a 'prospective buyer'
2 and 'seller' respectively along with 'the option of provision of a sample of a particular
3 commodity desired for purposes of indicating the quality desired by a prospective seller', or
4 'a model ... by a prospective buyer'.
5

6 7. Applicant respectfully submits that all the grounds of rejection under 35 U.S.C. 35
7 103(a) have been overcome by the declaration and exhibit attached hereto establishing
8 invention: i.e. conception, exercise of due diligence, and reduction to practice in the form of
9 the present application; of the presently claimed invention prior to *Lerner*, the primary
10 reference relied upon in rejection of all present claims under 35 U.S.C. 103 conveyed in the
11 fifth Office action.

12
13 8. Applicant respectfully submits that no rejections are outstanding other than the
14 rejections conveyed by the fifth Office action and that no objections to the present
15 application are outstanding.
16

17 9. Applicant respectfully submits that the grounds of the outstanding rejections under:
18 35 U.S.C. §112 have been overcome herein by a showing that the phraseology concerned
19 in the present base claim is fully defined in the specification and the phrase in the other
20 claims considered indefinite is, in every case, fully defined; 35 U.S.C. § 103(a) have been
21 overcome by: the declaration and exhibit attached hereto establishing invention prior to the
22 effective filing date of *Lerner*; as well as the demonstrations that claimed limitations of the
23 present base claim are neither undisclosed nor suggested by this prior art.

Application No. 09/866,652
Filed May 30th 2001

Art Unit: 3624

Examiner: Kyle, Charles R.
Applicant: Tommaso Innocenti

APPLICANT'S RESPONSE TO THE FIFTH OFFICE ACTION

1 10. Applicant respectfully submits that, for all the reasons above, the present application
2 for patent is in full and proper condition for allowance which action is further respectfully
3 and humbly requested.

4

5 Respectfully yours,

6

7 
8

9 Peter Gibson, Reg. #34,605
10 Tel. 410/358-5912; Fax -9636